

REMARKS

I. Status of the Claims

Claims 1-69 are currently pending in this application. Claims 14-21, 24-29, and 31-65 stand withdrawn from consideration as being drawn to non-elected subject matter. Without prejudice or disclaimer, claims 5 and 67 are amended herein to delete the term "type." Support for this amendment may be found in the specification as originally filed. Accordingly, no new matter is introduced herein.

Applicants thank the Examiner for her indication at page 8 of the Office Action, that claim 8 contains allowable subject matter. However, Applicants choose not to rewrite the claim in independent form at this time as Applicants believe all claims to be patentable for at least the reasons set forth below.

Further, Applicants respectfully remind the Examiner, if any of the elected species are found allowable, of her duty to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a "reasonable" number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

II. Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 5 and 67 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. See Office Action at 3.

Specifically, the Office states that the term "type" in the claims is subjective and thus unclear. *Id.* While Applicants believe the original claim language is clear, Applicants have amended claims 5 and 67 to remove this term. As such, Applicants assert that this rejection is obviated and request that it be withdrawn.

III. Rejections Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-7, 9-13, 22, 23, and 30 under 35 U.S.C. § 103(a) as unpatentable over WO 99/13846 ("Luo") in view of U.S. Patent No. 4,256,458 to Degen et al. ("Degen"). Office Action at 4. The Examiner has also rejected claims 66-69 under 35 U.S.C. § 103(a) as unpatentable over Luo and Degen in view of U.S. Patent No. 6,451,068 to Genet et al. ("Genet"). Office Action at 8. Applicants respectfully disagree with both of these rejections as discussed below.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also M.P.E.P. § 2141 (II). It is important to note that in this evaluation the references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02(vi), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In addition, the Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." M.P.E.P. § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Exemplary rationales that may support a conclusion of obviousness include, *inter alia*, "simple substitution of one known element for another to obtain predictable results" and "some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." M.P.E.P. § 2143.

Applicants assert that these criteria have not been met here for at least the following reasons.

A. Rejection over Luo and Degen

The Examiner asserts that Luo discloses hair care compositions comprising an effective amount of an optical brightener and a silicone compound, and further discloses shampoo compositions that also contain a deterotive surfactant. Office Action at 5. According to the Examiner, Luo states that optical brighteners are also called fluorescent dyes. *Id.* The Examiner further alleges that the preferred silicones of Luo are encompassed by the aminosilicones of formula (A) as recited in present claim 12. *Id.* The Examiner admits that Luo does not disclose the elected fluorescent dye of formula F(3) recited in claim 6, and to correct this deficiency, cites Degen, pointing to its teachings of methine dyes corresponding to the present formula F(3). *Id.* The Examiner concludes that one of ordinary skill in the art would have been motivated to use the dyes of Degen in the composition of Luo "since both references are drawn to dyeing processes involving anionically modified fibers." *Id.* Applicants respectfully disagree.

First, Applicants assert that Luo teaches optical brighteners and not fluorescent dyes, regardless of the nomenclature employed by Luo. Although Luo states that optical brighteners "can be described by other names in the art" including fluorescent dyes, it is clear from both the disclosures of Luo and the present application that the optical brighteners of Luo do not include fluorescent dyes as generally understood by those skilled in the art. See Luo at pg. 3 and Present Application at [020]-[021]. The present application states that "fluorescent dye as disclosed herein can be differentiated

from an optical brightener." Present Application at [020]-[021]. Both the present application and Luo note characteristics of optical brighteners that are not shared by fluorescent dyes: optical brighteners absorb light in the ultraviolet region with major absorption peaks ranging from about 200 to 400 nm, and emit light in the visible region of the spectrum. *Id.* In contrast, as is well known in the art, fluorescent dyes absorb in the visible spectrum and possibly in the ultraviolet spectrum, such as wavelengths ranging from about 360 to 700 nm, and emit fluorescent light of a longer wavelength in the visible region of the spectrum. *Id.* Therefore, regardless of what other names optical brighteners may be called, the disclosures of Luo and the present application make clear that the optical brighteners of Luo are not fluorescent dyes. As such, as skilled artisan would not be motivated to incorporate fluorescent dyes, which are colored, into the compositions taught by Luo, which contain an uncolored optical brightener.

Moreover, Applicants assert that when Luo and Degen are each considered in their entirety, there is simply no motivation to combine their teachings. Degen is directed to methods of dyeing paper and anionically modified fibers. Keratin materials are strictly different from synthetic paper materials. One of ordinary skill in the art reading Degen would understand that these fibers are anionically modified synthetic fibers, not human keratin materials. Further supporting this point is the fact that every single example of Degen contains solvents that are not "cosmetically acceptable" as required by the present claims. Acetic acid, acetone, piperidine, picoline, xylylene

dichloride, ethylene glycol monomethyl ether, among others, are all used in Degen's examples. Each of these compounds is classified as toxic and/or corrosive and/or harmful. Not a single one is suitable for use on human hair or skin. Accordingly, there is absolutely no reason why one of ordinary skill in the art of hair dyeing, looking at Luo, would have been motivated to look to Degen's paper and synthetic fiber dyeing compositions.

Furthermore, Degen does not teach or suggest any lightening effect on dark materials through the use of the disclosed fluorescent dyes. Therefore, one skilled in the art would have no motivation to exchange a fluorescent whitening agent disclosed in Luo with a fluorescent dye disclosed in Degen with a real hope of lightening dark keratin fibers as an alternative to lightening dark hair with a common oxidizing agent. For at least these reasons, this rejection is improper and Applicants respectfully request that it be withdrawn.

In addition, Applicants take issue with the Examiner's unfounded assertion that Luo teaches anionically modified fibers. Applicants assert that there is absolutely no teaching or suggestion in Luo that the keratin fibers are anionically modified by the use of anionic surfactants. The Examiner appears to be casually making assumptions to establish a motivation to combine the teachings of Luo and Degen. Following the Examiner's logic, a skilled artisan, upon reading the disclosure of Luo, must divine from the Examples that the keratin fibers *might* be anionically modified by the anionic surfactants listed among myriad different components in the exemplary compositions.

The skilled artisan must come to this conclusion absent any such teaching or suggestion from the disclosure of Luo. The skilled artisan must then equate these allegedly modified keratin fibers with anionically modified synthetic fibers. This position is both illogical and unfounded.

Regardless of whether Luo discloses anionically modified fibers, Applicants assert that such a recitation would not motivate an artisan skilled in the cosmetic arts use a paper dye in a cosmetic composition. In view of the material differences between Luo and Degen, one of ordinary skill in the art would not have been motivated to modify Luo in the manner asserted by the Examiner, e.g. to incorporate the dyes of Degen. As such, for at least this additional reason, the §103(a) rejection of claims 1-7, 9-13, 22, 23, and 30 is improper, and should be withdrawn.

B. Rejection over Luo, Degen and Genet

The Examiner concedes that Luo and Degen fail to teach multi-compartment kits as disclosed in present claims 66-69. Office Action at 8. Regardless of what Genet may teach with respect to multi-compartment kits, Applicants assert that Genet does not rectify the deficiencies of Luo and Degen as discussed above. Therefore, this rejection is legally insufficient and Applicants respectfully request that it be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of the pending claims and their timely allowance.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4368.

Please grant any extensions of time required to enter this paper and charge the required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 4, 2008

By: Deborah M. Herzfeld
Deborah M. Herzfeld
Reg. No. 52,211